

Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Paper 28

Filed: February 28, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

E. I. du Pont De Nemours and Company,
Junior Party
(Application 09/882,719,
Inventors: Robert Joseph Bouchard, Lap-Tak Andrew Cheng,
John Gerard Lavin and David Herbert Roach),

v.

Industrial Technology Research Institute,
Senior Party
(Patent 6,436,221
Inventors: Yu-Yang Chang, Jyh-Rong Sheu,
and Cheng-Chung Lee).

Patent Interference 105,514 (RES)
(Technology Center 1700)

Before SCHAFER, TORCZON and MOORE, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

JUDGMENT

1
2 This interference is between Industrial Technology Research Institute's (ITRI) Patent
3 6,436,221 and du Pont's Application 09/882,719. The interference was declared because an
4 interference-in-fact existed between ITRI's Claim 1 and du Pont's Claim 82. ITRI's Claims 1-9
5 and Du Pont's Claims 1-11, 54-56, 60-63, 66, 69-80, 82, 92 and 93 were designated as
6 corresponding to the count.

1 ITRI has filed a reissue application, that includes a preliminary amendment canceling all
2 of ITRI's patent claims and substituting narrower Claims 10-22. ITRI's reissue declaration (37
3 CFR § 1.175) acknowledges that "claim 1 does not particularly point out and distinctly claim
4 what is regarded as the invention, in accordance with 35 U.S.C. § 112, second paragraph."
5 Exhibit 1001, p. 18.

6 Du Pont acknowledges that its Claim 82--a substantial copy of ITRI's Claim 1-- has the
7 same indefiniteness problem. Du Pont has orally offered to file an amendment canceling claim
8 82.

9 Both parties desire to return to ex parte examination.

10 Under the particular facts and circumstances it is appropriate to terminate this
11 interference returning jurisdiction to the Commissioner of Patents. The principal basis upon
12 which this interference was declared --an interference-in-fact between ITRI's Claim 1 and du
13 Pont's Claim 82--no longer exists. Additionally, both ITRI's reissue and du Pont's applications
14 require further examination. An interference is not the best forum for conducting this
15 examination.

16 We terminate this interference with a judgment of unpatentability of ITRI's Claims 1-9
17 and du Pont's Claim 82. The termination is without prejudice to any appropriate ex parte
18 examination including suggesting another interference between any patentable claims in ITRI's
19 reissue and patentable claims in du Pont's application.¹

20 Since no motions were authorized or filed, the estoppel provisions of 37 CFR § 41.127(a)
21 do not apply. However, this judgment finally disposes of ITRI Claims 1-9 and du Pont Claim
22 82. 37 CFR § 41.127(b).

23 ORDER

24 It is

25 **ORDERED** that ITRI is not entitled to a patent containing Claims 1-9 of Patent
26 6,436,221;

27 **FURTHER ORDERED** that du Pont is not entitled to a patent containing Claim 82 of
28 Application 09/882,719;

¹ This decision does not compel the Commissioner of Patents to reopen prosecution of du Pont's application. Any further prosecution is at the discretion of the Commissioner.

1 **FURTHER ORDERED** that the estoppel provisions of 37 CFR § 41.127(a) do not apply
2 against the parties;

3 **FURTHER ORDERED** that a copy of this judgment be made of record in the file of
4 Patent 6,436,221 and Application 09/882,719;

5 **FURTHER ORDERED** that if there is any settlement agreement that has not been filed,
6 attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 41.205; and

7 **FURTHER ORDERED** that any settlement agreement may be filed in paper rather than
8 by e-mail.
9

/Richard E. Schafer/)
 RICHARD E. SCHAFER)
 Administrative Patent Judge)

/Richard Torczon/) BOARD OF PATENT
 RICHARD TORCZON) APPEALS AND
 Administrative Patent Judge) INTERFERENCES

/James T. Moore/)
 JAMES T. MOORE)
 Administrative Patent Judge)

cc (electronic filing):

Counsel for DuPont:
Todd R. Walters, Esq.
BUCHANAN INGERSOLL & ROONEY
1737 King Street, Suite 500
Alexandria, VA 22314-2727
Tel: 703-836-6620
Email: todd.walters@bipc.com

Counsel for ITRI:
Mark D. Sweet, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
Tel: 202-408-4000
Email: mark.sweet@finnegan.com

Desperтт, Sonja

From: Desperтт, Sonja on behalf of Interference Trial Section
Sent: Wednesday, February 28, 2007 3:07 PM
To: 'todd.walters@bipc.com'; 'mark.sweet@finnegan.com'
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